

REMARKS

This Amendment is submitted in response to the Office Action dated December 30, 2004. In the Office Action, the Patent Office rejected Claims 1-18 under 35 U.S.C. §103(a) as being unpatentable over *Greco et al.* (U.S. Patent Pub. No. 2002/0120680 A1) in view of *Heston* (U.S. Patent Pub. No. 2002/0019741 A1).

By the present Amendment, Applicant amended Claims 1, 3 and 12. Applicant submits that the amendments to independent Claims 1 and 12, in view of the following comments, overcome the rejection of Claims 1-18 under 35 U.S.C. §103(a) as being unpatentable over *Greco et al.* in view of *Heston* and place the application in condition for allowance. Notice to that effect is requested.

In the Office Action, the Patent Office asserts:

Greco teaches a method and system for providing electronic document services, comprising:
Claims 1 and 12,

 providing a service provider and user (client) computer...

 providing a database accessible by the user...

 inputting user unique information into the database via the user computer... utilizing demographic information...

 automatically delivering an item by one of said document-related services...[and]

 generating and transferring user fees, postage costs, and special service mail provider costs [0097].

However, *Greco* does not specifically teach that said forms include *forms, which are used for creation [of] said document* (communication).

Further, the Patent Office asserts that:

Heston teaches a method and system for performing legal services over the internet, wherein a client is presented with a choice of legal documents to be created. In use, the client selects the legal document that he wants to prepare, and enters into the legal document form necessary information to create the legal document.

Independent Claim 1, as amended, defines a system to assist a user with preparation and mailing of a communication requiring delivery by a special service wherein the special service has fees associated with postage and services to effect the delivery by the special service. The system has a computer accessible site that automatically prepares the communication and provides for automatic payment of the fees associated with the postage and the services required to effect the delivery by the special service.

Further, Independent Claim 1, as amended, requires a computer that accesses a database that is remotely located with respect to the computer. The database stores the communication, stores instructions to assist the user to complete the communication, stores criteria regarding selection of the special service appropriate for the delivery of the communication and stores requirements to effect the delivery of the communication by the

special service. Still further, independent Claim 1, as amended, requires the communication to be selected via the computer, automatically prepared in compliance with the requirements of the delivery by the special service and automatically mailed by the special service.

Independent Claim 12, as amended, defines a method for assisting with preparation and automatic mailing of a communication requiring delivery by a special service. The method has the steps of providing a computer-accessible site and providing a database accessible by a user via the computer-accessible site. The database is remotely located with respect to the user. Further, the database stores instructions to assist the user to complete the communication, stores criteria regarding selection of the special service appropriate for the delivery of the communication, stores requirements to effect the delivery of the communication by the special service, stores the communication, and stores a directory of mailing addresses that is accessed to confirm an address of a recipient of the communication.

Moreover, independent Claim 12, as amended, requires the step of inputting information into the database regarding demographics of the user wherein the requirements to effect the delivery of the communication by the special service are based on the demographics of the user. Further, independent Claim 12,

as amended, requires the steps of selecting a geographical region within which the communication is to be delivered and preparing the communication according to selection of the geographical region. Still further, independent Claim 12, as amended, requires the steps of automatically mailing the communication, generating fees, postage costs, and special service mail provider costs, and automatically paying the fees.

Contrary to the assertions of the Patent Office, *Greco et al.* merely teach or suggest electronic document services that utilize a database that "may include multiple entries that contain a user identification data (ID) field 710 and user data field 720. The user ID field 710 may contain an identifier that uniquely identifies the user. The user data field 720 may include one or more subfields... a link information field 722, a service provider information field 724, and possibly a permissions field 726." Further, *Greco et al.* teach that the link information field 722 contains links to web sites maintained by service providers, the service provider information field 724 contains information about the type of service, etc. provided by service providers, and the permissions field 726 contains information about the permissive uses of services by each user.

Contrary to the assertions of the Patent Office, *Heston* merely teaches or suggests a system and method for rendering legal services that utilizes a database for storage and retrieval of user interface and information that is manipulated by program logic. Further, the database stores legal forms and topical or legal area information.

Clearly, neither *Greco et al.* nor *Heston*, taken singly or in combination, teach or suggest a database that stores the communication, stores instructions to assist the user to completely prepare the communication, stores criteria regarding selection of the special service appropriate for the delivery of the communication and stores requirements to effect the delivery of the communication by the special service, as required by independent Claim 1, as amended. Further, neither *Greco et al.* nor *Heston*, taken singly or in combination, teach or suggest that the communication is automatically prepared in compliance with the requirements of the delivery by the special service and automatically mailed by the special service via the computer accessible site, as required by independent Claim 1, as amended.

Moreover, neither *Greco et al.* nor *Heston*, taken singly or in combination, teach or suggest the step of providing a database accessible by a user via the computer-accessible site that stores instructions to assist the user to completely

prepare the communication, stores criteria regarding selection of the special service appropriate for the delivery of the communication, stores requirements to effect the delivery of the communication by the special service, stores the communication, and stores a directory of mailing addresses that is accessed to confirm an address of a recipient of the communication, as required by independent Claim 12, as amended. Further, neither *Greco et al.* nor *Heston*, taken singly or in combination, teach or suggest the step of inputting information into the database regarding demographics of the user via the computer-accessible site wherein the requirements to effect the delivery of the communication by the special service are based on the demographics of the user, as required by independent Claim 12, as amended.

Still further, neither *Greco et al.* nor *Heston*, taken singly or in combination, teach or suggest the steps of selecting a geographical region within which the communication is to be delivered and preparing the communication according to selection of the geographical region, as required by independent Claim 12, as amended. Moreover, neither *Greco et al.* nor *Heston*, taken singly or in combination, teach or suggest the steps of automatically mailing the communication by the special service,

generating fees and automatically paying the fees, as required by independent Claim 12, as amended.

With respect to the rejection of Claims 1-18 under 35 U.S.C. §103(a), one of ordinary skill in the art would never have been motivated to modify *Greco et al.* with *Heston* in the manner suggested by the Patent Office in formulating the rejection of the claims under 35 U.S.C. §103(a). It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most, if not all, elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's system and method for automating delivery of communication by a special service, either separately or used in

other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of *Greco et al.* and *Heston* in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to combine *Greco et al.* and *Heston* to produce the claimed invention. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103.

In view of the foregoing, the rejection of Claims 1-18 under 35 U.S.C. §103(a), in view of *Greco et al.* and further in view of *Heston* has been overcome and should be withdrawn. Notice to that effect is requested.

Claims 2-11 depend from Claim 1; and Claims 13-18 depend from Claim 12. These claims are also believed allowable since each sets forth additional structural elements and novel steps of Applicant's system and method, respectively.

In view of the foregoing remarks and amendments, Applicants respectfully submit that all of the claims in the application are in allowable form and that the application is now in condition for allowance. If, however, any outstanding issues

remain, Applicants urge the Patent Office to telephone Applicants' attorney so that the same may be resolved and the application expedited to issue. Applicants request the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,

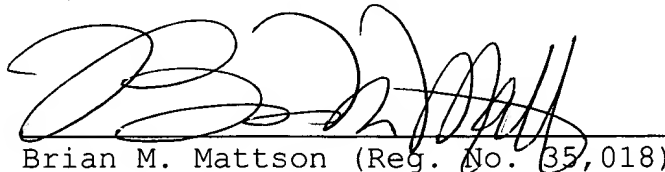


(Reg. No. 35,018)

Brian M. Mattson
Patents+TMS
A Professional Corporation
1914 N. Milwaukee Ave.
Chicago, Illinois 60647
Telephone: (773) 772-6009
Attorney for Applicant

CERTIFICATE OF MAILING

I hereby certify that this **Amendment** is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 30, 2005.



Brian M. Mattson (Reg. No. 35,018)